

### **REMARKS**

Applicants thank the Examiner for total consideration given the present application. Claims 1-26 are currently pending in the application of which claims 1, 6, and 14 are independent. Claim 1 has been amended through this reply. Applicants respectfully request favorable consideration in light of the remarks contained herein, and earnestly seek timely allowance of the pending claims. Applicants respectfully submit that the amendment made to claim 1 does not add any new matter to the instant application. Support for this amendment can be found on page 11 of the specification.

### **Claim Rejections - 35 U.S.C. § 103**

**Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Akazuka (JP 62252583) in view of Steve's DigiCams: "PowerShot S10 User Review", [Online] 1999, Internet address <[http://www.steves-digicams.com/pdf/canon\\_s10.pdf](http://www.steves-digicams.com/pdf/canon_s10.pdf)> (hereinafter "Steve").** Applicants respectfully traverse this rejection in view of the following remarks.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See M.P.E.P. 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See M.P.E.P. 2142; M.P.E.P. 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, it is respectfully submitted that the combination of Akazuka and Steve fails to teach or suggest one or more elements of independent claims 1, 6, and 14.

Claim 1 discloses, *inter alia*, “displaying selectable candidates for a **number of imaging pixels and image compression rates in compression operation in a two-dimensional arrangement** on a setting screen for setting an image quality; presenting to a user **combinations of selectable number of imaging pixels and the image compression rates and at the same time** receiving an instruction for moving a cursor on the setting screen, wherein the number of imaging pixels and the image pixels and image compression rates in a two-dimensional arrangement compression rates are **each directly selectable.**” The combination of Akazuka and Steve fails to disclose the above identified claim elements.

Akazuka merely discloses an image file device, which has a recording means, which computes the remaining number of images that be stored in the remaining storage capacity (see first paragraph, page 2). Moreover, Akazuka discloses a display unit 23 and display Table 1, which presents in a tabular form data recording length based upon the combination of three modes. The first mode allows one to select the structural pixel number of an image wherein the selectable pixel numbers are 640x480 pixels or 320x240 pixels. The second mode allows one to select an option to perform data compression wherein the **compression rate is one-half**. Finally, the third mode allows one to perform image recording as black and white, or as a color image. (see page 5, lines 15-28.)

Akazuka is distinguished by the present invention in that Akazuka fails to display a number of “**compression rates**” (*emphasis added*) on the display unit 23. Claim 1 requires that more than one compression rate be displayed as selectable compression rates in combination with more than one imaging pixels. As demonstrated above, Akazuka provides **only one** compression rate (one-half) to perform data compression. Akazuka’s compression rate of one-

half is **not** even a **selectable candidate** since this is the only rate available for data compression. As demonstrated above, in Akazuka, a user can select three modes as a recording mode in image recording and have two options for each mode element as follows: (i) pixel numbers (640x480 pixels or 320x240 pixels); (ii) compression rate (no-compression or one-half compression); (iii) color (monochrome or color). As a result, it is possible to select one of eight patterns of data recording length in total as in table 1. However, table 1 in Akazuka is a table to explain eight combinations defined by the above-described three modes (i) to (iii), and it is not a screen for user interface to be displayed on the display unit 23 in actual device. Accordingly, it is respectfully submitted that Akazuka cannot teach displaying selectable candidates **for a number of imaging pixels and image compression rates in compression operation in a two-dimensional arrangement** as required by independent claim 1.

Similarly, at least for the same reasons as demonstrated above with respect to claim 1, Akazuka cannot teach or suggest, at least, “a display control device that **displays selectable candidates in a two-dimensional array for number of imaging pixels and image compression rates on the setting screen of said display device**, wherein the selectable candidates present combinations of directly selectable numbers of pixels and compression rates,” as recited in claim 6; and “**displaying selectable options for image compression rates and image pixel quantities, wherein the image compression rates and image pixel quantities are each directly selectable using the selectable options, arranging the options in a two-dimensional format according to predetermined combinations,**” as recited in claim 14.

As argued previously, Steve merely discloses a review of the Canon PowerShot S10 digital camera which provides a user menu allowing the user to select a number of parameters to

control the operation of the digital camera. The parameter labels are listed in a column of the left hand side of the screen. (see page 11.) When one of the parameter labels is selected, specific values associated with that parameter appeared to the right of the parameter label which may be subsequently set by the user. For example, as shown in the Figure on page 11, the user has selected "resolution" using the camera's 4-way "Omni Selector" (see page 4).

Once "resolution" is selected, choices associated with specific values of the resolution, "L" for 1,600 x 1,200 pixels, "M" for 800 x 600 pixels, or "S" 640 x 480, are shown. Once the specific resolution value is selected, the user may scroll down to the list and select another parameter label to change. For example, as shown in bottom Figure of page 12, the user has selected the "gain" parameter label, and as a result, the options "0," "+1.0," and "+2.0" are subsequently displayed. Note that for the "resolution" parameter label, only the option previously selected ("L") appears, and the other options are not shown because that parameter was not the one most recently selected.

As shown on page 11, the resolution options are "L", "M" and "S" and are only displayed when the "resolution" parameter label is selected. Below that is the compression parameter label which merely displays "S" for superfine, is displayed. Other options which would appear when the compression parameter is selected is "F" for Fine and "N" for Normal.

Steve therefore fails to disclose, at least: "displaying selectable candidates for a number of imaging pixels **and image compression rates in compression operation in a two-dimensional arrangement** on a setting screen for setting an image quality," as recited in claim 1; "a display control device that **displays selectable candidates in a two-dimensional array for number of imaging pixels and image compression rates on the setting screen of said display**

**device**, wherein the selectable candidates present combinations of directly selectable numbers of pixels and compression rates,” as recited in claim 6; and **“displaying selectable options for image compression rates and image pixel quantities, wherein the image compression rates and image pixel quantities are each directly selectable using the selectable options, arranging the options in a two-dimensional format according to predetermined combinations,”** as recited in claim 14.

Steve is distinguished by the present invention in that Steve merely displays the selectable specific value choices **in a linear fashion** after the parameter label has been selected. Steve **cannot display** the resolution and the compression choices **simultaneously** which is inherently disclosed by the instant claim since the number of imaging pixels and the image compression rates are **each directly selectable**. In Steve, once one parameter’s choice has been selected, and the user moves on to the next parameter to select it, the previous choices are no longer displayed and only the choice that was previously selected remains displayed. Therefore, Steve’s disclosure **cannot show displaying selectable candidates for a number of imaging pixels and image compression rates in compression operation in a two-dimensional arrangement (claim 1)**. Furthermore, neither Akazuka nor Steve can display the resolution and the compression choices **simultaneously** which is inherently disclosed by the instant claims since the number of imaging pixels and the image compression rates are **each directly selectable and arranged in a two-dimensional array (claim 6) or format (claim 14)**.

**In addition, there is no motivation to combine Akazuka and Steve.** It is respectfully submitted that the two cited references taken either alone or in combination do not recognize the

problem solved by the Applicants' claimed invention or include all the features of independent claims as discussed above. More specifically, the Applicants' claimed invention solves the unrecognized problem of displaying selectable options for image compression rates and image pixel quantities, wherein the image compression rates and image pixel quantities are each directly selectable using the selectable options, arranging the options in a two-dimensional format according to predetermined combinations. Moreover, it is respectfully submitted that only a person skilled in the art who had access to the present application would be motivated to combine the teachings of the cited prior art references in order to solve the unrecognized problem disclosed in Applicants' specification. In other words, the only motivation to combine the cited references in the way suggested in the Office Action is gleaned from the hindsight provided by Applicant's specification. Particularly, as demonstrated above, table 1 in Akazuka is a table to explain eight combinations defined by the above-described three modes (i) to (iii), and it is **not a screen** for user interface to be displayed on the display unit 23 in actual device. Therefore, one of ordinary skill in the art **would not be motivated to apply the table 1** in Akazuka, indicated to explain recording mode, **as a user interface screen** in camera of Steve.

The Applicants further respectfully submit that the Office Action is based upon a selective combination of features found in the references, and that such selective combining is impermissible. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985), "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." It is respectfully submitted that the Office Action cites

Akazuka and then utilizes the present application as a road map to selectively replace or add various features of Akazuka with Steve.

The Office Action admits that Akazuka fails to teach the claimed step of receiving an instruction for moving a cursor on the setting screen and changing a setting which are pointed by the cursor after designating a position of the cursor, but alleges that the Steve reference evidences “that one of ordinary skill in the art at the time to see more advantages for the camera system using instruction key to move a cursor on the setting screen so that the camera setting mode or data can be quickly and easily selected by user.” Thus, the Examiner concludes that “it would have been obvious to see the camera system receiving an instruction for moving a cursor on the setting screen; and changing a setting to the number of pixels and the image compression rate which are pointed by the cursor after designating a position of the cursor as disclosed by Steve” (see page 3, lines 15-21 of the Office Action). It is respectfully submitted that the rejection of independent claims 1, 6, and 14 is a blatant string of substitutions gleaned from and motivated by the Applicants’ own patent application. The Office Action has not shown that the prior art provides the teaching or suggestion to make the claimed combination and the reasonable expectation of success. The suggestion to make the claimed combination and the reasonable expectation of success cannot be based on Applicants’ disclosure.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 1, 6, 14 based on the impermissible combination of Akazuka and Steve.

Claims 2-5, 7-13, and 15-26 are at least allowable by virtue of their dependency on corresponding allowable independent claims.

**CONCLUSION**


In view of the above remarks, applicants believe that the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam, Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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